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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,925	07/19/2006	Bernard C. B. Lim	355908-3814	1105
38706 7590 06/26/2008 FOLEY & LARDNER LLP 975 PAGE MILL ROAD PALO ALTO, CA 94304				
EXAMINER HAYMAN, IMANUN				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/553,925

**Applicant(s)**

LIM ET AL.

**Examiner**

IMANI HAYMAN

**Art Unit**

4116

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 October 2005 and 19 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 50-98 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 50-98 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/883)
- Paper No(s)/Mail Date 7/19/06
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. In response to the Preliminary Amendments filed on October 21, 2005 and July 19, 2006, claims 1-49 have been cancelled, and the newly added claims 50-98 are pending.

### ***Specification***

2. The use of the trademark MICROID has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
5. Claims 50-98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. (US Patent No. 7,322,355 B2) in view of De La Huerga (US Patent No. 7,216,802 B1).

Regarding claim 50, Jones et al. discloses a dispenser having an outlet for delivering one or more materials (see column 2, lines 51-63 and column 12, lines 40-60). However, Jones et al. fail to disclose a dispenser with identifier means and a controller. De La Huerga discloses a first and second identifier means as well as a permission controller (see column 3, lines 32-49). Hence, at the time of invention it would have been obvious to one skilled in the art to combine the teachings of Jones et al. with De La Huerga to create a dispenser capable of identifying and verifying user and medicament data to ensure consumer safety.

Regarding claim 51, Jones et al. disclose a system wherein the entity is a dispensing recipient, a medical professional or a clinician (see column 2, lines 66-67 and column 3, line 1).

Regarding claims 52, 67, 85 and 86, Jones et al. discloses a dispenser (see column 2, lines 51-63 and column 12, lines 40-60). However, Jones et al. fail to disclose identifier elements. De La Huerga discloses a system wherein the entity is a dispensing recipient and the second identity data is embedded in, carried by or emitted by an article carried externally or internally by the recipient (see figure 15); wherein the second identifier comprises a band or ring to be worn a leg, arm or neck of the recipient (see column 18, lines 32-33); and wherein the first and second identifiers include complementary first and second key formations located on, in or near the valve and the article respectively (see column 16, lines 29-56). Hence, at the time of invention it would have been obvious to one skilled in the art to combine the teachings of Jones et al. with De La Huerga to create a system whereby identifying data is carried on a patient or clinician that must correspond with identification device before medication can be released.

Regarding claim 53, Jones et al. disclose a system wherein the dispenser control includes an access controller for controlling access to the outlet (see column 2, lines 66-67 and column 3, lines 1-10).

Regarding claim 54, Jones et al. disclose a system wherein the access controller includes a valve, an outlet blockage member, or both (see column 2, lines 66-67 and column 3, lines 1-10).

Regarding claim 55, Jones et al. disclose a system wherein the valve or outlet blockage member is operable between an open position and a closed position, and is normally closed (see column 3, lines 23-25).

Regarding claim 56, Jones et al. disclose a system wherein the access controller is a valve comprising a variable aperture valve member, a controlled valve member, a proportional valve member or a combination thereof (see column 3, lines 11-18).

Regarding claim 57, Jones et al. disclose a system wherein the valve is a pulse width modulated on-off valve (see column 9, lines 1-3).

Regarding claim 58, Jones et al. disclose a system wherein the access controller includes an outlet blockage member comprising a lockable cap member (see column 3, lines 26-32).

Regarding claims 59-64, Jones et al. discloses a dispenser (see column 2, lines 51-63 and column 12, lines 40-60). However, Jones et al. fail to disclose identifier elements. De La Huerga discloses a system wherein the first or second identifier, or both, are arranged to retain the first identity data or the second identity data in electronic, graphical, mechanical or nuclear form (see column 9, lines 41-50); convey data on a carrier wave (see column 9, lines 41-50; and a system wherein the permission controller includes a comparator (see column 9, lines 46-67 and column 18, lines 65-67). Hence, at the time of invention it would have been obvious to one skilled in the art to combine the teachings of Jones et al. with De La Huerga to create a system capable of identifying and relaying user and prescription data and determining if the data corresponds with the identification device.

Regarding claim 65, Jones et al. disclose a system wherein the first identifier is operable to convey the first identity data in a form detectable by a biometric sensor, an optical character reader, a magnetic strip reader, an RFID reader or a combination thereof (see column 11, lines 14-20).

Regarding claim 66, Jones et al. disclose a system wherein the first identifier includes a signal emitter and/or receiver to emit and/or receive signals in the visible or invisible frequency spectrums (see column 15, lines 21-30).

Regarding claim 68, Jones et al. disclose a system wherein the second identifier includes an identification chip such as an RFID tag associated with the second identity data (see column 15, lines 31-34).

Regarding claim 69, Jones et al. disclose a system wherein the access controller is a valve and the first identity data includes valve identity data to identify the valve; and the second identification data includes article identity data to identify an article associated with the entity; the permission controller being operable to open the outlet when there is a match between the valve identity data and the article identity data (see column 3, lines 19-25).

Regarding claim 70, Jones et al. disclose a system wherein the permission controller is operable to close the valve to block access to the outlet when there is a mismatch between the valve identity data and the article identity data (see column 3, lines 19-25).

Regarding claim 71, Jones et al. disclose a system wherein the permission controller is resident in an intermediate controller module which is operable within signal receiving range of the valve and the article (see column 3, lines 19-25).

Regarding claim 72, De La Huerga discloses an access controller comprising a valve powered by a power supply (see column 14, lines 24-36). Hence, at the time of invention it would have been obvious to one skilled in the art to combine the teachings of Jones et al. with De La Huerga to create a dispenser a valve powered controller to regulate opening and closure.

Regarding claim 73, Jones discloses a system wherein the access controller comprises a valve powered by a power supply (see column 7, lines 44-61).

Regarding claim 74, Jones et al. discloses a system wherein the power supply includes a power source residing in the power supply, a conductive path to an external power source, or are inductive power-generating module which is responsive to externally applied radiation, or a combination thereof (see column 7, lines 44-61).

Regarding claim 75, Jones et al. disclose a system wherein the power supply portion is integral within the dispenser (see column 7, lines 44-61).

Regarding claim 76, Jones et al. disclose a system wherein the power supply is an inductive power generating module, and the externally applied radiation is within the microwave or radio wave frequency ranges (see column 7, lines 44-61).

Regarding claims 77-84, Jones et al. discloses a dispenser (see column 2, lines 51-63 and column 12, lines 40-60). However, Jones et al. fail to disclose controller elements. De La Huerga discloses a system wherein the permission controller

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comprises a key associated with the second identity data (see column 16, lines 29-56). Hence, at the time of invention it would have been obvious to one skilled in the art to combine the teachings of Jones et al. with De La Huerga to create a dispenser using a security system to identify data and release medicated content upon verification recognition.

Regarding claim 87, Jones et al. disclose a system wherein the dispenser comprises at least one member selected from the group consisting of syringe, IV bottle, powder dispenser, atomized fluid dispenser, gas inhalant dispenser, implant delivery dispenser, ventilator, syringe pump, intubation tube and a gastrointestinal feeding tube (see column 4, lines 7-11).

Regarding claim 88, Jones et al. disclose a system wherein the dispenser is a syringe having a barrel portion, and plunger portion, the plunger portion positioned in the barrel portion (see column 3, lines 6-10).

Regarding claim 89, Jones et al. disclose a system wherein the dispenser control is a lock for locking the position of the plunger (see column 3, lines 6-32 and column 4, lines 24-27).

Regarding claim 90, Jones et al. disclose a system wherein the syringe has a valve downstream of and separable from the barrel, and wherein the permission controller includes a comparator for comparing the first identity data with the second identity data, the comparator being located at the valve (see column 3, lines 6-32 and column 4, lines 24-27).

Regarding claim 91, Jones et al. disclose a system wherein the dispenser control includes a valve located in the barrel portion or downstream thereof (see column 3, lines 6-32 and column 4, lines 24-27).

Regarding claim 92, Jones et al. disclose a system wherein the dispenser control includes a blockage member located in the barrel or downstream thereof (see column 3, lines 6-32 and column 4, lines 24-27).

Regarding claim 93, Jones et al. disclose a system wherein the outlet is downstream of the barrel and the dispenser control includes a valve in a valve housing attachable with and separable from the outlet (see column 3, lines 6-32 and column 4, lines 24-27).

Regarding claim 94, Jones et al. disclose a system wherein the entity is a dispensing recipient selected from a medical patient, an experimental subject and a candidate for a treatment or procedure (see column 2, lines 66-67 and column 3, line 1).

Regarding claim 95, Jones et al. disclose a system wherein the dispensing recipient is mammalian (see column 2, lines 66-67 and column 3, line 1).

Regarding claim 96, Jones et al. disclose a system wherein the dispensing recipient is a human being (see column 2, lines 66-67 and column 3, line 1).

Regarding claims 97 and 98, Jones et al. discloses a dispenser (see column 2, lines 51-63 and column 12, lines 40-60). However, Jones et al. fail to disclose the material aspects of the system. De La Huerza discloses a system wherein the material has beneficial properties to enhance life, to promote health, to cure and/or treat a disease, condition or ailment, to monitor and/or indicate a bodily function or a

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combination thereof; and wherein the material is useful for IV therapy, implantation, stem cell therapy, oncology therapy, blood transfusion and/or organ transplantation (see column 26, lines 7-25). Hence, at the time of invention it would have been obvious to one skilled in the art to combine the teachings of Jones et al. with De La Hueraga to create a system incorporating a medicament frequently used in patient care settings that can be controlled via an information device.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to IMANI HAYMAN whose telephone number is (571)270-5528. The examiner can normally be reached on MONDAY THRU FRIDAY 7:30 AM TO 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOE CHENG can be reached on 571-272-4433. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/I. H./  
Examiner, Art Unit 4116  
6/18/08

/Joe H Cheng/  
Supervisory Patent Examiner  
Art Unit 4116